

## REMARKS

Claims 37, 45, 49, and 61 are canceled without prejudice. Claims 73-75 are added without introducing new matter.

### Claim Rejections - 35 U.S.C. §102

Claims 37, 40-50, 53-61 and 64-72 are rejected, under 35 U.S.C. §102(b), as being allegedly anticipated by Margraff et al., (WO 01/83213 A1) (hereinafter Margraff). Independent Claims 37, 49, and 61 are canceled without prejudice, thereby obviating the rejection. Independent Claims 73-75 have been added and are patentable over Margraff in view of the following.

Independent Claim 73 recites an input device operable to read a first plurality of substantially invisible codes disposed on a surface, wherein a first print element is disposed on the first plurality of substantially invisible codes, and wherein the first plurality of substantially invisible codes provides location information of the first print element, as claimed.

In contrast, Margraff discloses that the pages of the print media includes any suitable substrate material, e.g., paper or plastic (see Margraff, page 9, lines 4-5) and that print is permanently affixed to the substrate material, e.g., ink on paper (see Margraff, page 9, lines 7-8). Margraff discloses that the print medium may be a transparency (see Margraff, page 9, line 12). Margraff also discloses a print media receiving unit for receiving the print medium (see Margraff, page 7, lines 16-19). The print media receiving unit includes an electronic detection

system for determining a position of a portion of a print medium selected by the user (see Margraff, page 8, lines 12-15). The electronic detection system includes electronic elements that are embedded under the print media receiving unit (see Margraff, page 25, lines 24-25).

Accordingly, Margraff discloses determining a position of a portion of a print element using electronic elements of the receiving unit. Margraff fails to teach or suggest a plurality of substantially invisible codes disposed on a surface for providing location information of the print element in the claimed fashion because the print medium, as disclosed by Margraff, does not provide a location information since the location is determined using electronic elements of the receiving unit. As such, Margraff fails to teach or suggest an input device operable to read a first plurality of substantially invisible codes disposed on a surface, wherein a first print element is disposed on the first plurality of substantially invisible codes, and wherein the first plurality of substantially invisible codes provides location information of the first print element, as claimed.

Accordingly, Margraff fails to anticipate independent Claim 73, under 35 U.S.C. §102(b). Independent Claims 74 and 75 recite limitations similar to that of independent Claim 73 and are patentable for similar reasons. Dependent claims are patentable by virtue of their dependency. As such, allowance of Claims 73-75, 40-44, 46-48, 50, 53-60 and 64-72 is earnestly solicited.

#### Claim Rejections - 35 U.S.C. §103

Claims 38, 39, 51, 52, 62 and 63 are rejected, under 35 U.S.C. §103(a), as being allegedly unpatentable over Margraff in view of Kardach (U.S. 2003/0001020) (hereinafter Kardach). Claims 38, 39, 51, 52, 62 and 63 depend from independent Claims 73, 74 and 75 and are patentable over the cited references by virtue of their dependency. As such, allowance of Claims 38, 39, 51, 52, 62 and 63 is earnestly solicited.

Claims 37-72 are rejected, under 35 U.S.C. §103(a), as being allegedly unpatentable over Silverbrook (U.S. 6,678,499) (hereinafter Silverbrook) in view of Nagasaki et al., (U.S. 5,896,403) (hereinafter Nagasaki). Independent Claims 37, 49, and 61 are canceled without prejudice, thereby obviating the rejection. Independent Claims 73-75 have been added and are patentable over the cited combination in view of the following.

Independent Claim 73 recites an input device operable to read a first plurality of substantially invisible codes disposed on a surface, wherein a first print element is disposed on the first plurality of substantially invisible codes, and wherein the first plurality of substantially invisible codes provides location information of the first print element, as claimed.

In contrast, Silverbrook discloses that coded data on the form is indicative of the identity of the form and at least one reference point on that form (see Silverbrook, col. 4, lines 5-7). Silverbrook further discloses that the coded data is indicative of parameters on the form whereas the sensing device is operative to

provide data regarding its own movement relative to that form to the computer system (see Silverbrook, col. 4, lines 7-11).

Accordingly, the coded data provides information regarding the form, as disclosed by Silverbrook, and not location information of print elements, as claimed. For example, the movement relative to the form is provided by the sensing device and not the coded data on the form, as disclosed by Silverbrook. As such, Silverbrook fails to teach or suggest an input device operable to read a first plurality of substantially invisible codes disposed on a surface, wherein a first print element is disposed on the first plurality of substantially invisible codes, and wherein the first plurality of substantially invisible codes provides location information of the first print element, as claimed.

Independent Claim 73 further recites that in response to the determining the first position, mapping the first position to a location memory that a first instructional response associated with the first location is stored, wherein the first instructional response is an instruction from the computing device for use by a user of the computing device, as claimed.

In contrast, Silverbrook discloses that the examinee provides an answer for each examination question (see Silverbrook, col. 46, lines 31-39).

Accordingly, the response is from a person and not the device, as claimed.

Moreover, mapping to a location memory that a first instructional response is stored, as claimed is not performed, as disclosed by Silverbrook, since the

response is from a person. As such, Silverbrook fails to teach or suggest that in response to the determining the first position, mapping the first position to a location memory that a first instructional response associated with the first location is stored, wherein the first instruction response is an instruction from the computing device for use by a user of the computing device, as claimed.

Nagasaki fails to remedy the failures of Silverbrook, as discussed above. More specifically, Nagasaki fails to teach or suggest an input device operable to read a first plurality of substantially invisible codes disposed on a surface, wherein a first print element is disposed on the first plurality of substantially invisible codes, and wherein the first plurality of substantially invisible codes provides location information of the first print element, as claimed. Moreover, Nagasaki fails to teach or suggest that in response to the determining the first position, mapping the first position to a location memory that a first instructional response associated with the first location is stored, wherein the first instruction response is an instruction from the computing device for use by a user of the computing device, as claimed.

Accordingly, Silverbrook alone or in combination with Nagasaki fails render independent Claim 37 obvious, under 35 U.S.C. §103(a). Independent Claims 74 and 75 recite limitations similar to that of Claim 73 and are patentable for similar reasons. Dependent claims are patentable by virtue of their dependency. As such, allowance of Claims 73-75, 38-44, 46-48, 50-60, and 62-72 is earnestly solicited.

For the above reasons, the Applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. §102 and 35 U.S.C. §103.

### CONCLUSION

In light of the above listed remarks, reconsideration of the rejected Claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 73-75, 38-44, 46-48, 50-60, and 62-72 overcome the rejections of record and, therefore, allowance of Claims 73-75, 38-44, 46-48, 50-60, and 62-72 is earnestly solicited.

Please charge any additional fees or apply any credits to our PTO deposit account number: 50-4160.

Respectfully submitted,  
MURABITO, HAO & BARNES LLP

Dated: 8-14-2009

/Amir A. Tabarrok/  
Amir A. Tabarrok  
Registration No. 57,137

MURABITO, HAO & BARNES LLP  
Two North Market Street  
Third Floor  
San Jose, California 95113

(408) 938-9060 Voice  
(408) 938-9069 Facsimile